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OFFICE OF PETITIONS

In re Application of
de Souza, Pessler, and Merry,
Application No. 09/730,383
Filed: December 6, 2000
For: E-COMMERCE APPLICATION
SERVICE PROVIDER MICRO-BILLING
METHOD AND SYSTEM

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:

This is in response to the "Petition Under 37 CFR 1.47(a)," filed June 8, 2001 and accompanied by a three month extension of time within the maximum extendable time for reply from the Notice to File Missing Parts mailed January 17, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 6, 2000 without an executed oath or declaration and naming de Souza, Pessler, and Merry, as joint inventors.

Accordingly, on January 17, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a filing fee, and a surcharge for their late filing.

In response, on June 8, 2001, a Response to the Notice to File Missing Parts was filed which contained the following items:

- 1) two separate Declarations for Patent application with Power of Attorney with each executed by one of the inventors and the late surcharge fee;
- 2) a copy of the Notice to file Missing Parts;
- 3) petition for three month extension of time and associated fee;
- 4) Petition under 37 CFR 1.47(a) and associated fee;
- 5) Assignments and the associated fees.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1), (2), and (4) set forth above.

As to item (1), Petitioner appears to demonstrate that Mr. Pessler was only presented with the declaration and Power of Attorney. It is stated in paragraph 6 of the petition, signed by Mr. Thomas Champagne, that declarations were sent to Mr. de Souza and Mr. Pessler by airmail and facsimile transmission, yet no proof was provided. Paragraph 7 states that communications were received back from Mr. Pessler but not Mr. de Souza. Unless Mr. de Souza was presented with a copy of the application papers (specification, claims and drawings), Mr. de Souza could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. Accordingly, Rule 47 applicant failed to show or provide proof that the inventor has refused to sign the declaration. See Manual of Patent Examining Procedure, Section 409.03(d). Petitioner should show that a copy of the application papers was presented to the inventor, but that he did not respond to or refused the request that he sign the oath/declaration in order to show that the inventor has refused to join in the application. Paragraphs 8 and 9 of the petition explain that Douglas J. Ryder, an attorney acting on behalf of the Assignee, has made numerous attempts to contact Mr. de Souza. A declaration from Douglas J. Ryder, Attorney acting on behalf of the Assignee, has not been provided as evidence of his involvement and attempts to contact Mr. de Souza. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. All the

inventors must be listed on the declaration that is executed. Furthermore, when there are joint inventors, the term "first and sole inventor" should not be utilized with respect to any of the inventors. The term should be "first and joint inventor". The claims of domestic priority under 119(e) and 120 should be included. It is noted that the first declaration has an attorney docket number of TPL 119 and lists de Souza, Passerl, and Merry as the inventors, with only de Souza signing. The second declaration has an attorney docket number of WEB2000-05 and lists de Souza and Merry as the inventors with only Merry signing. Therefore, there seems to be a mix-up between two different application files. The correct inventorship should first be determined and then an oath or declaration in compliance with 37 CFR 1.63 and 1.64 and executed by the appropriate inventors on behalf of themselves and the non-signing inventor is REQUIRED. See MPEP 409.03(a).

As to item (4), a statement of the non-signing inventor's last known address is missing and is required.

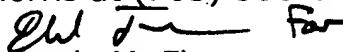
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA

Telephone inquiries related to this decision should be directed to Lesley Morris at (703) 306-0028.


Beverly M. Flanagan
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for Patent Examination Policy